



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/459,788	06/02/95	HARVEY	J 5634.243

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LM61/0323

EXAMINER

CUMMING, W

ART UNIT

PAPER NUMBER

2744

DATE MAILED:

03/23/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory ActionApplication No.
08/459,788Applicant(s)
HARVEY, et alExaminer
WILLIAM D. CUMMINGGroup Art Unit
2744**THE PERIOD FOR RESPONSE: [check only a) or b)]**

- a) ☐ expires _____ months from the mailing date of the final rejection.
- b) ☒ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Mar 2, 1998 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

☒ The proposed amendment(s):

- ☒ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
- ☐ will not be entered because:
- ☐ they raise new issues that would require further consideration and/or search. (See note below).
 - ☐ they raise the issue of new matter. (See note below).
 - ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

- ☐ Applicant's response has overcome the following rejection(s):
- _____
- _____

- ☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.
- ☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:
NOTE ATTACHMENT
- _____

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):
- Claims allowed: none
- Claims objected to: none
- Claims rejected: 5-34

- ☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Other

WILLIAM D. CUMMING
PRIMARY EXAMINER
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4. The amendment filed March 8, 1998 under 37 CFR 1.116 in reply to the final rejection has been entered, but is not deemed to place the application in condition for allowance. For purposes of appeal, the status of the claims is as follows:

Allowed claim(s): NONE

5 **Rejected claim(s): 5-34**

Claim(s) objected to: NONE

5. The request for reconsideration has been entered and considered but does not overcome the rejection.

10 Receipt is acknowledged of applicant's Information Disclosure Statements filed March 2, 1998. In view of the unusually large number of references cited in the instant application (approximately 2,200 originally and 645 in the subsequent IDS) these references have been considered in accordance with 37 C.F.R. 1.97 and 1.98 to the best ability by the examiner with the time and
15 resources available.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the step of receiving an information transmission containing processor instruction and a program and the step of programming the receiver station to perform a
20 predetermined secondary error correction routine in accordance with the

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processor instruction as stated by claim 5; the step of clearing at least a portion of the memory as stated by claim 5; the step of one of placing and replacing data at the memory to one of complete and correct a program element in consequence of the step of executing a predetermined secondary error

5 correction routine as stated by claim 7; the step of receiving an information transmission at a transmission station, the information transmission containing only a portion of processor instruction and a program, the step of generating the remainder of the program, the step of transmitting the information transmission containing the program and the processor instructions, wherein the processor

10 instructions program the receiver to perform a predetermined secondary error correction routine in accordance with the processor instructions, wherein the program enabled the receiver station to perform a primary error correction routine by processing at least a portion of the information transmission, discerning a failure evidencing one of an incomplete and an incorrect program

15 element by reprocessing information received in the information transmission as stated by claim 23; the step of effects a transmission station to generate a program, the receiver station to perform a primary error correction routine by processing at least a portion of the information transmission, discerning a failure evidencing one of an incomplete and an incorrect program element by

20 reprocessing information received in the information transmission, the step of

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effects a receiver station to generate a program, the receiver station to perform a primary error correction routine by processing at least a portion of the information transmission, discerning a failure evidencing one of an incomplete and an incorrect program element by reprocessing information received in the information transmission as stated by claim 24; and the method steps of claims 25-34, must be shown or the features canceled from the claims. No new matter should be entered. CFR §1.83 (a) clearly states:

*“(a) The drawing in a nonprovisional application **must show every feature of the invention specified in the claims.** However, conventional features disclosed in the description and claims, where their **detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation** (e.g., a labeled rectangular box).”*

If the drawings show the claimed subject matter as stated by applicants without any details, the Examiner can not see these method steps in the drawings. The Applicants must show, if their statement is correct, all claimed subject matter in the drawings completely and in detailed as the Examiner objected to them.

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Since Applicants have refused to show every feature of the invention specified in the claims the drawings, Applicants' response supports the inadequacy of support in the specification of these steps in the claimed method. In order to satisfy "*written description*" requirement of 35 USC §112 for drawings, the proper test is whether drawings convey, with reasonable clarity to those of ordinary skill in the art, the claim subject matter. The drawings do not convey, with any reasonable clarity to those of ordinary skill in the art, these steps in the claimed method. The "*written description*" of the invention required by first paragraph of 35 USC §112 is separate and distinct from that paragraph's requirement of enabling disclosure, since description must do more than merely provide explanation of how to "*make and use*" the invention. Applicants must also convey, with reasonable clarity to those skilled in the art, that applicants, as of the filing date sought, was in possession of the invention, with the invention being, for purpose of "*written description*" inquiry, whatever is presently claimed. Applicants do not convey, with any reasonable clarity to those skilled in the art, that applicants, as of the filing date sought, was in possession of the invention, with the invention being, for purpose of "*written description*" inquiry, whatever is presently claimed. "*New matter*" prohibition of 35 USC §112 plays important role in establishing filing date of application as prima facie date of invention. Patent laws do not permit insertion of additional descriptive matter subsequent

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to filing date in order to complete disclosure so as to conform specification's description of the invention to statutory standard (Ex parte Maizel, 27 USPQ2d 1662). Applicants have cut and paste their best mode presentation in the description, with unrelated functions as steps, into a singled claimed method.

5 These newly claimed steps have no nexus with other steps. These steps are not shown or describe how these claimed steps are integrated into a single method as claimed by Applicants. Its seems that the Applicants wrote the claims in total disregard if the description supports the method with the claimed step. Each claimed step may have support individually, but there is no nexus with that step
10 with the other steps claimed in the method. Adequacy of written description does not depend upon length of that description, but rather upon content of description in relation to particular invention (In re Hayes Microcomputer Products Incorporated, 25 USPQ2d 1241).

Conflicts exist between claims of the following related co-pending
15 applications which includes the present application:

#	Ser. No.	#	Ser. No.	#	Ser. No.
1	397371	2	397582	3	397636
20 4	435757	5	435758	6	437044

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	7	437045	8	437629	9	437635
	10	437791	11	437819	12	437864
	13	437887	14	437937	15	438011
	16	438206	17	438216	18	438659
5	19	439668	20	439670	21	440657
	22	440837	23	441027	24	441033
	25	441575	26	441577	27	441701
	28	441749	29	441821	30	441880
	31	441942	32	441996	33	442165
10	34	442327	35	442335	36	442369
	37	442383	38	442505	39	442507
	40	444643	41	444756	42	444757
	43	444758	44	444781	45	444786
	46	444787	47	444788	48	444887
15	49	445045	50	445054	51	445290
	52	445294	53	445296	54	445328
	55	446123	56	446124	57	446429
	58	446430	59	446431	60	446432
	61	446494	62	446553	63	446579
20	64	447380	65	447414	66	447415

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	67	447416	68	447446	69	447447
	70	447448	71	447449	72	447496
	73	447502	74	447529	75	447611
	76	447621	77	447679	78	447711
5	79	447712	80	447724	81	447726
	82	447826	83	447908	84	447938
	85	447974	86	447977	87	448099
	88	448116	89	448141	90	448143
	91	448175	92	448251	93	448309
10	94	448326	95	448643	96	448644
	97	448662	98	448667	99	448794
	100	448810	101	448833	102	448915
	103	448916	104	448917	105	448976
	106	448977	107	448978	108	448979
15	109	449097	110	449110	111	449248
	112	449263	113	449281	114	449291
	115	449302	116	449351	117	449369
	118	449411	119	449413	120	449523
	121	449530	122	449531	123	449532
20	124	449652	125	449697	126	449702

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	127	449717	128	449718	129	449798
	130	449800	131	449829	132	449867
	133	449901	134	450680	135	451203
	136	451377	137	451496	138	451746
5	139	452395	140	458566	141	458699
	142	458760	143	459216	144	459217
	145	459218	146	459506	147	459507
	148	459521	149	459522	150	459788
	151	460043	152	460081	153	460085
10	154	460120	155	460187	156	460240
	157	460256	158	460274	159	460387
	160	460394	161	460401	162	460556
	163	460557	164	460591	165	460592
	166	460634	167	460642	168	460668
15	169	460677	170	460711	171	460713
	172	460743	173	460765	174	460766
	175	460770	176	460793	177	460817
	178	466887	179	466888	180	466890
	181	466894	182	467045	183	467904
20	184	468044	185	468323	186	468324

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	187	468641	188	468736	189	468994
	190	469056	191	469059	192	469078
	193	469103	194	469106	195	469107
	196	469108	197	469109	198	469355
5	199	469496	200	469517	201	469612
	202	469623	203	469624	204	469626
	205	470051	206	470052	207	470053
	208	470054	209	470236	210	470447
	211	470448	212	470476	213	470570
10	214	470571	215	471024	216	471191
	217	471238	218	471239	219	471240
	220	472066	221	472399	222	472462
	223	472980	224	473213	225	473224
	226	473484	227	473927	228	473996
15	229	473997	230	473998	231	473999
	232	474119	233	474139	234	474145
	235	474146	236	474147	237	474496
	238	474674	239	474963	240	474964
	241	475341	242	475342	243	477547
20	244	477564	245	477570	246	477660

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	247	477711	248	477712	249	477805
	250	477955	251	478044	252	478107
	253	478544	254	478633	255	478767
	256	478794	257	478858	258	478864
5	259	478908	260	479042	261	479215
	262	479216	263	479217	264	479374
	265	479375	266	479414	267	479523
	268	479524	269	479667	270	480059
	271	480060	272	480383	273	480392
10	274	480740	275	481074	276	482573
	277	482574	278	482857	279	483054
	280	483169	281	483174	282	483269
	283	483980	284	484275	285	484276
	286	484858	287	484865	288	485282
15	289	485283	290	485507	291	485775
	292	486258	293	486259	294	486265
	295	486266	296	486297	297	487155
	298	487397	299	487408	300	487410
	301	487411	302	487428	303	487506
20	304	487516	305	487526	306	487536

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307	487546	308	487556	309	487565	
310	487649	311	487851	312	487895	
313	487980	314	487981	315	487982	
316	487984	317	488032	318	488058	
5	319	488378	320	488383	321	488436
	322	488438	323	488439	324	488619
	325	488620	326	498002	327	511491
	328	485773	329	113329		

10 37 CFR 1.78(b) provides that when two or more applications filed by the
same applicant contain conflicting claims, elimination of such claims from all but
one application may be required in the absence of good and sufficient reason for
their retention during pendency in more than one application.. However, an
analysis of all claims in the 329 related co-pending applications would be an
15 extreme burden on the Office requiring millions of claim comparisons. In order
to resolve the conflict between applications, applicant is required to either:

- (1) file terminal disclaimers in each of the related 329
applications terminally disclaiming each of the other 329
applications, or;

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(2) provide an affidavit attesting to the fact that all claims in the 329 applications have been reviewed by applicant and that no conflicting claims exists between the applications. Applicant should provide all relevant factual information including the specific steps taken to insure that no conflicting claims exist between the applications, or;

(3) resolve all conflicts between claims in the above identified 329 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 329 applications (note: the five examples in the attached Appendix are merely illustrative of the overall problem. Only correcting the five identified conflicts would not satisfy the requirement).

Failure to comply with the above requirement will result in

abandonment of the application

In response to applicant's argument , the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of

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ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In response to applicant's argument, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In

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response to applicant's argument that some references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In response to applicant's arguments, a preamble is generally not accorded any patentable weight where it merely

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recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant's arguments do not comply with 37 CFR 1.111© because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In response to Applicant's argument that the references includes additional structure not required by Applicant's invention, it must be noted that references discloses the invention as claimed. The fact that

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it discloses additional structure not claimed is irrelevant. Applicant can not show non-obviousness by attacking references individually where, as here, the rejections are based on combination of references (In re Keller, 208 USPQ 1981). During examination before the Patent and Trademark Office, claims must be given their broadest reasonable interpretation and limitations from the specification may not be imputed to the claims (Ex parte Akamatsu, 22 USPQ2d, 1918; In re Zletz, 13 USPQ2d 1320, In re Priest, 199 USPQ 11). In response to Applicant's argument, it has been held that the mere fact that the references relied on by the Patent and Trademark Office fail to evince an appreciation of the problem identified and solved by applicant is not, standing alone, conclusive evidence of the nonobviousness of the claimed subject matter. The references may suggest doing what an applicant has done even though workers in the art were ignorant of the existence of the problem.

It has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961). Prior art reference that "teaches away" from claimed invention is significant factor to be considered in determining obviousness, but the nature of such teaching is highly relevant and must be weighed in substance (In re Gurley, 31 USPQ2d, 1130). The fact that no one

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has gotten a patent on this specific combination does not necessarily means that it is not obvious. It merely means that no one has gotten a patent on this combination. The reason why might be, simply, because the combination is obvious. It is not necessary that the references actually suggest, expressly or in so many words, the changes or improvements that applicant has made. The test for combine references is what the references as a whole would have suggested to one of ordinary skill in the art (In re Sheckler, 168 USPQ 716; In re McLaughlin 170 USPQ 209; In re Young, 159 USPQ 725). If it is obvious to combine references for one reason, it is obvious to combine references for all reasons (In re Graf, 145 USPQ 197; In re Finsterwalder, 168 USPQ 530; In re Kronig, 190 USPQ 425; In re Dillion, 13 USPQ 1337 and 16 USPQ 1897). The test for obviousness is not what is obvious to the applicant but what would have been obvious to a person having ordinary skill in the art. The actual applicant's skill is irrelevant (E.I. du Pont de Nemours and Company v. Cetus Corporation, 19 USPQ2nd 209).

Obviousness is a question of law on series of factual determinations, including the scope and the content of prior art, differences between the art and the claims at issue and the level of ordinary skill in the art (General Instrument Corporation v. International Trade Commission, 20 USPQ2nd 203). The explicit suggestion to substitute one equivalent for another meet not be demonstrated to

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render such substitution obvious (In re Front, Mishkin and Roychoudhury, 213 USPQ 532). The combination was obvious to start with and the resulting alluring properties would not make less obvious (Forbro Design Corporation v. Raytheon Company, 190 USPQ 49). A prima facie case of obviousness is establish when

5 the teachings of the prior art would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. The combined teachings of the prior art need not provide an absolute prediction of success for the claimed subject matter. Instead, only a reasonable likelihood of success is required (In re Ball Corporation, 18 USPQ 2d 1491). The examiner, in the Patent and

10 Trademark Office proceedings, bears the burden of establishing prima facie case of obviousness based upon prior art. The examiner can satisfy this burden only showing some objective teaching in the prior art, or by showing that knowledge which is generally available to a person of ordinary skill in the art would lead that individual to combine references relevant teaching (Ex parte

15 Obukowicz, 27 USPQ2d 1063).

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Motivation for combining prior art references need not be explicitly found in the references themselves, and the Examiner may provide explanation based on logic and sound reasoning that will support a holding of obviousness (Ex parte Levengood, 28 USPQ2d, 1300). Applicants' arguments appear to be directed primarily to comparisons of the method or manner of intended use of the apparatus rather to delineating claimed structure not shown or made obvious by the prior art.

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Applicants argue that the finality of the last office action should be withdrawn because the amended claim is still in the same scope or subject matter. Due to the change in practice as affecting final rejections, older decisions on questions of prematureness of final rejection or admission of subsequent amendments do not necessarily reflect present practice. Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces **a new ground of rejection not necessitated by amendment of the application by applicant**, whether or not the prior art is already of record. The Examiner finds it contradictory that Applicants amends claim five with thirty-eight additional words and state that these added words and limitations are not found in the reference, hence the claims is patentable over the reference. It is clear that Applicants amended the claims to over come the references, hence the amendment caused the new grounds of rejection. The Applicants are trying iniquitously to receive additional chances to amend their claims which the prior art found exceedingly obvious and extremely unpatentable. Hence, the request to withdraw the final of the last Office action is DENIED.

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6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to **Primary Examiner Cumming** whose telephone number is **(703) 305-4394**. The Examiner can normally be reached on Monday through Thursday (and alternate Fridays) from 8:30am to 6:00pm, EST. Any inquiry of a
5 general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is **(703) 305-3900**.

Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks

10 Washington, D.C. 20231

or faxed to:

(703) 305-9051, (for formal communications; please mark
"EXPEDITED PROCEDURE")

Or:

15 **(703) 305-9508** (for informal or draft communications, please label
"PROPOSED" or *"DRAFT"*)

Hand-delivered responses should be brought to Crystal Park II, 2021
Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).